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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,056	11/17/2003	Donald R. Jones	DRJ-001	3681
26654 7590 08/06/2007 BUTZER & CHEN LAW, LLC 870 HIGH STREET, SUITE 104 WORTHINGTON, OH 43085			EXAMINER SHAH, MILAP	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 08/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,056

Applicant(s)

JONES, DONALD R.

Examiner

Milap Shah

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-16,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2007 has been entered.

The Examiner acknowledges that claims 1, 8, 15, & 16 are amended, claims 6, 7, 17, 20 & 21 are previously canceled, and no new claims are added. Therefore, claims 1-5, 8-16, 18, & 19 are currently pending.

Claim Objections

Claim 10 is objected to because of the following informalities: Claim 10 depends from a canceled claim. For purposes of examination, the Examiner will interpret claim 10 as being dependent from independent claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam (U.S. Patent No. 4,741,537) in view of Tarbox, Jr. (U.S. Patent No. 5,647,805).

Claims 1 & 15: Adam generally discloses a golf-teeing device having a golf ball storage and feeding means in combination with a tee-lifting means which are selectively actuatable for smoothly and efficiently placing golf balls upon a tee at a desired height without the need for adjustment of the golfers stance or handgrip. Adam discloses the invention substantially as claimed, including an automatic tee-up device with a golf ball reservoir (figure 1[8]) and a platform (figure 1[25]) with a groove (figure 1[54]) for a golf ball to travel from the reservoir to a tee, where the tee is movable from below a level of the golf ball in the groove to above the level of the golf ball in the groove (figures 1, 5, 8, & 9, column 2, lines 20-65, and column 3, line 34 – column 7, line 6). Adam also discloses a ball ejector (figure 1[37]) disposed to eject golf balls one at a time from the reservoir onto the groove (figures 1, 5, 8, & 9, and column 6, lines 25-41), wherein after the golf ball is ejected by the ejector, the golf ball travels on the groove to the tee and is raised by the tee into a position suitable for striking with a golf club (column 3, line 34 – column 7, line 6). Adam also discloses a lever (figure 1[7]) that projects from the platform and that actuates the ball ejector and the tee via a head of a golf club (figures 1, 3, & 6 and column 3, lines 40-44). Regarding claim 15, the method limitations coincide with the structural limitations of the device disclosed above and can be seen ascertainable via the disclosure above.

Adam explicitly lacks disclosing and/or teaching the lever projecting from the platform is specifically actuated on a horizontal plane in a horizontal arc. Regardless of this deficiency, it would have been extremely obvious for the designer of Adam's system to try various actuation systems when finally coming to the conclusion that the pedal actuation system appeared to work best, nevertheless, Tarbox, Jr. explicitly teaches and discloses a lever in an automatic teeing device that actuates the process of moving a ball from the reservoir to the tee based on the end of the lever moving in a horizontal arc (see at least figures 1 & 2, where figure 2 shows the explicit

movement of the lever from a first position represented by solid lines and a second position represented by the dotted lines, and movement from the first position to the second position occurs by moving an end of the lever in a horizontal arc at least when viewing the invention from a top-view perspective similarly to as Adam is viewed to have a lever that is depressed in the vertical direction). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Adam's lever/pedal actuation system such that the lever/pedal was to be moved in a horizontal arc as taught by Tarbox, Jr. at least for the reason that various actuation systems are interchangeable to those of ordinary skill in the art, and because such a modification to Adam via the teaching of Tarbox, Jr. would have only required routine skill in the art.

Alternatively, as a side note, without need of the secondary reference, the Examiner respectfully submits that modifying the actuation system from the vertical plane to the horizontal plane does not appear to be patentability distinct and would have been obvious to try as common sense to one of ordinary skill in the art since that person of ordinary skill in the art has good reason to pursue known options within his or her technical grasp (i.e. "Do I want a system where the golf presses a button or do I want a system where a golfer actuates a lever?", such in a pinball machine where a player pulls on a lever in the horizontal direction to eject a ball, thus, it is submitted that such mechanical options to the designer are well known in the art), which may lead to anticipated or predictable success, thus, such modifications are not likely to be the product of innovation but rather of ordinary skill and common sense.

Claim 2: Adam discloses the platform includes a mat that has a groove (figures 1 & 3).

Claim 3: Adam discloses the mat with the groove is removable from the rest of the platform (figure 3).

Claim 4: Adam discloses the platform includes at least one other mat (figure 1[2]) positioned where a golfer stands on the platform (figure 1 and column 3, lines 36-37).

Claims 5 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam & Tarbox, Jr., as applied to claims 1-4 & 15, where applicable, further in view of Chang (U.S. Patent No. 5,529,307).

Claims 5 & 16: The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed except for explicitly disclosing an agitating block within the golf ball reservoir so as to allow golf balls to eject one at a time, where the golf balls are agitated within the reservoir. However, Chang discloses an analogous automatic golf ball teeing device in which an agitator is explicitly disclosed to be disposed within the bin or reservoir of balls so as to simulate some movement to prevent the balls from clogging or jamming within the bin or reservoir (Chang, column 3, lines 5-11, where either the plate or arm may be considered the “agitator block” in the two agitator embodiments disclosed). Motivation lies within the definition, the agitator agitates the balls to prevent clogging or jamming, thus, one of ordinary skill would have found it obvious to modify the combination of Adam & Tarbox, Jr. for at least the same reason to avoid any jamming or clogging of the balls within the reservoir that fall down the tubes of the device, one at a time. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Adam & Tarbox, Jr. with the teaching of Chang at least for the purpose of preventing jams in the automatic tee-up device.

Claims 8-10, 18, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam & Tarbox, Jr., as applied to claims 1-4 & 15, where applicable, further in view of Eckardt, Jr. (U.S. Patent Application Publication No. 2003/0162598).

Claims 8, 9, & 18: The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed including, regarding claim 9, the tee is removable so as to facilitate replacement of the tee. The tee is removable because it may be glued in place and the height of the tee may be increased or decreased by increasing or decreasing the number of spacers (Adam, figure 7[91]). However, Adam appears to lack explicitly disclosing the lever is connected to a ramp and the tee is connected to a tapered block (extension 62) that rests on the ramp such that movement of the ramp causes the tee to raise or to lower. Eckardt, Jr. explicitly discloses the lever is connected to a ramp and the tee is connected to a tapered block that rests on the ramp such that movement of the ramp causes the tee to raise or lower (Eckardt, Jr., figures 2 & 7, and paragraphs 0012, 0018, 0020-0024, 0057, 0072-0076, 0096, 0097, & 0106). It would have been obvious at the time of Applicant's invention to modify the lever of the combination of Adam & Tarbox, Jr. with that of Eckardt. One would be motivated to do such that a golfer is then able to practice with different clubs at various tee heights, such as when driving it we beneficial to the golfer to have the tee up higher than say that for a nine iron or a putter.

Claims 10 & 19: The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed including different positions of the lever corresponding to different tee heights (figures 2 & 7 and paragraphs 0012, 0018, 0020-0024, 0057, 0072-0076, 0096, 0097 & 0106). The combination appears to explicitly lack disclosing a scale adjacent the lever corresponding to the tee heights. Regardless of the deficiency it would have been an obvious matter of routine skill in the art to add a scale or some type of numbering system adjacent the lever to correlate the different positions of the lever to different tee heights. Eckardt explicitly discloses a system in which the tee is moveable to a desired height and the explicit advantage of such a system that is able to vary the height of the tee for accommodating a range of golfers with different preferences (paragraph

0101). Thus, it would have been natural for one of ordinary skill, such as the designer of the system, to include a scale or numbering system to correlate the different positions of the lever to a height of the tee in a conventional system (i.e. a number of inches) for at least the reason that a golfer is able to experiment as to figure out what tee height works best and consistently use said tee height each time he returned to use the device without having to go through the process of determining what tee height suits him best. There are a plurality of prior art devices that are notoriously well known in the art that are used by golfers to put tees into the ground at specific heights, such devices provide motivation to achieve the same effect in an automatic tee-up device where the platform the golfer is able to get the same tee height he may use on the golf course via one of these well known tools to help golfers place their tees at a specific height. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Adam & Tarbox, Jr. as discussed above.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam & Tarbox, Jr., as applied to claims 1-4 & 15, where applicable, further in view of Lai (U.S. Patent No. 4,779,796).

Claim 11: The combination of Adam & Tarbox, Jr. discloses the invention substantially as claimed except for explicitly disclosing one or more leveler feet on which the platform rests, the leveler feet permitting the platform to be leveled. However, Lai, an analogous golf teeing device, teaches one or more leveler feet (wedge leaf 13) on which the platform rests, the leveler feet permitting the platform to be leveled (figures 1 & 10 and column 2, lines 6-12). Although the wedge leaves are typically used to simulate a sloping surface on a golf course, they may also be used to level the golf platform on an un-level surface. Lai provides motivation for such a modification by teaching a height adjustable golf platform, thus, such features were known and would have been easily

combinable or implemented into other known golf teeing systems such as that disclosed by the combination of Adam and Tarbox, Jr. Therefore, such a modification would have been prima facie obvious to one of ordinary skill in the art at the time of the invention.

Claim 12: Lai also discloses the platform folds along a hinge and may be locked such that the device may be stored away when not in use, thus, the combination of Adam, Tarbox, Jr., & Lai disclose the platform further includes at least one hinge by which the platform can be folded up.

Claim 13: The combination of Adam & Tarbox, Jr. discloses the groove is in a removable mat on the platform and the platform includes at least two mats positioned where a golfer stands on the platform (figures 1, 5, 8, & 9, column 2, lines 20-65, and column 3, line 34 – column 7, line 6).

However, the combination appears to lack in explicitly disclosing a seam between the two mats aligns with the hinge. Lai teaches such a seam (figures 6 & 13-15). It would have been obvious to align the seam with the hinge as is done in many industries when it comes to foldable/portable devices for the simple reason of aesthetics, to be user-friendly (i.e. a user is able to locate where it folds, quickly), and cost effectiveness. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Adam & Tarbox, Jr. for at least the reasons given above.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adam, Tarbox, Jr., & Lai, as applied to claims 11-13, where applicable, further in view of Koett (U.S. Patent No. 3,693,979).

Claim 14: The combination of Adam, Tarbox, Jr., & Lai disclose the invention substantially as claimed except for explicitly disclosing at least two wheels disposed for moving the automatic tee-up device when the platform is folded up. However, Koett, an analogous golf practice device, teaches roller means (78) supporting the device such that the device may be moved to any desired

location, thus, Koett teaches at least two wheels disposed for moving an automatic tee-up device when the platform is folded up. It would have been obvious at the time of Applicant's invention to modify the combination of Adam, Tarbox, Jr., & Lai with the roller means of Koett in order to roll the golf teeing device to any desired location or to be stored away when not in use.

Response to Arguments

Applicant's arguments with respect to claims 1-5, 8-16, 18, & 19 have been considered but are moot in view of the new ground(s) of rejection. An updated base rejection to at least claims 1 & 15 results in each rejection being new grounds of rejection. Additionally, at least two new references were introduced. See rejections above. A summary-like response to the arguments is provided below.

The Applicant's arguments appeared to include three overall arguments.

First, the Applicant argued that Adam did not disclose a lever moving in a horizontal arc. A new reference has been introduced which appears to disclose a lever moving in a horizontal arc in an analogous golf device. Additionally, the Examiner submits that it would have been within the level of ordinary skill to have converted Adam into a device where the lever moved in a horizontal direction instead of a vertical direction, as such a modification does not appear to be patentably distinct and it appears the invention would have worked equally well with such a modification.

Second, the Applicant argued, with respect to claims 5 & 16, that the cited references did not show an agitator block. See the newly added rejection in which a reference was found to explicitly show an agitator block within a reservoir that holds golf balls for an automatic golfing device.

Lastly, the Applicant argued, with respect to claims 10 & 19, that the art relied upon did not explicitly teach a scale. The Examiner agrees that a scale was not explicitly shown, however, it would have

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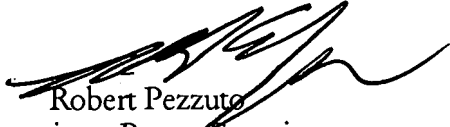
been obvious based on the disclosure of Eckardt to have implemented a scale. See the updated rejection for a more detailed response to this argument.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Robert Pezzuto
Supervisory Patent Examiner
Art Unit 3714

M.B.S.